UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,422	03/22/2001	Satoru Suzuki	09812.0161-00000	4553

22852 7590 10/04/2006

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER	
COLBERT, ELLA	

ART UNIT	PAPER NUMBER
3694	

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/815,422	SUZUKI ET AL.	
	Examiner	Art Unit	
	Ella Colbert	3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7 and 30-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-7 and 30-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 March 2001* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-7 and 30-33 are pending. Claims 1-7 and 30, and 32 have been amended in this communication filed 07/03/06 as Response After Non-Final Action.

2. The Amendment to the title has been reviewed and accepted.

3. The 35 USC 112 second paragraph has been overcome in part by Applicants' amendments and is hereby withdrawn in part as set forth here below.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Applicants' amendment to Claims 1 and 30 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Applicants' amendment after "function executing means" has a step critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). The step that is missing is a step that follows the functions, including playback, recording, fast forwarding and rewinding" take place. The missing step, for example is: executing and operating inputting means for executing and operating inputting of the functions including, playback, recording, fast forwarding, and rewinding;". Claim 3 has a similar problem.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants' regard as the invention.

The claims recite "chargeable amount ...". There is no positive recitation as to the "chargeable amount" in the recited step it is not considered limiting. It is unclear how the amount is charged and what the amount is charged on.

Examination has been done to the best of the Examiner's ability given the condition of the claims. The claims appear to be a literal translation from a foreign document rendering the claims vague and indefinite.

Claim Objections

8. Claims 1 and 30 are objected to because of the following informalities: Claim 1 as amended recites "... executing functions, including playback,". This limitation would be better recited as "... executing the functions, including playback," or "... executing said functions, including playback,". Appropriate correction is required.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-7 and 30-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over (US 6,198,915) McGregor et al, hereafter McGregor in view of (US 6,347,136) Horan..

Claim 1. McGregor discloses An electronic apparatus comprising: operation inputting means for designating one of a plurality of functions (col. 3, lines 42-51) measuring means for measuring the time during which each of said functions has been executed by said function executing means (col. 16, line 38-col. 17, line 5 and lines 31-38); and chargeable amount computing means for computing a chargeable amount

based on the execution time measured by said measuring means regarding each of said functions (col. 12, lines 44-52). McGregor failed to disclose function executing means for executing functions, including playback, recording, fast forwarding, and rewinding, designated by said operating inputting means. Horan discloses function executing means for executing functions, including playback, recording, fast forwarding, and rewinding, designated by said operating inputting means (col. 3, lines 35-60).

In treatment of the last limitation quoted above regarding a chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting on a function-by-function basis, it is understood that McGregor discloses a mobile phone with an internal account charging program which can compute a chargeable amount based on the time used for each function. Further the last limitation is broadly and reasonably interpreted as McGregor disclosing this limitation.

Claim 2. MCGregor discloses An electronic apparatus according to claim 1, wherein said chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting on a function-by-function basis (col. 18, lines 11-57).

Claim 3. McGregor discloses An electronic apparatus according to claim 2, wherein said function executing means is controlled by a microprocessor, and wherein said chargeable amount computing means computes said chargeable amount based on the execution time regarding each of said functions and through weighting by a load factor

of said microprocessor in effect during execution of each of said functions (col. 3, line 42-col. 4, line 9 and col. 18, lines 30-57).

Claim 4. McGregor discloses An electronic apparatus according to claim 2, wherein said chargeable amount computing means computes said chargeable time based on different weighting factors set for different apparatuses (col. 14, line 29-col. 15, line 42).

Claim 5. McGregor discloses An apparatus according to claim further comprising: storing means for storing execution times for each of said functions measured by said measuring means (col. 5, lines 24-44); and transmitting means for transmitting said execution times from said storing means to an external entity for settlement of charges (col. 14, lines 29-49).

Claim 6. McGregor discloses An electronic apparatus according to claim 1, further comprising: storing means for storing a chargeable time representing the chargeable amount computed by said chargeable amount computing means (col. 5, lines 24-44 and line 61-col. 6, line 8); and transmitting means for transmitting said chargeable time from said storing means to an external entity for settlement of charges (col. 3, line 52-col. 4, line 4 and lines 23-32 and col. 17, lines 31-38).

Claim 7. McGregor discloses An electronic apparatus according to claim 1, further comprising: storing means for storing a usable time of said apparatus (col. 5, lines 29-33 and line 61-col. 6, line 8); and settling means for subtracting a chargeable time representing the chargeable amount computed by said chargeable amount computing means, stored in said storing means, from said usable time stored in said storing means (col. 13, lines 41-48).

Claim 30. This independent claim is rejected for the similar rationale as given above for claims 1 and 6.

Claim 31. This dependent claim is rejected for the similar rationale as given above for claims 5 and 6.

Claim 32. This dependent claim is rejected for the similar rationale as given above for claims 1-3.

Claim 33. This dependent claim is rejected for the similar rationale as given above for claim 6.

Response to Arguments

13. Applicants' arguments filed 07/03/06 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: The prior art cited by the Examiner, McGregor, does not teach or suggest each and every element of claims 1-7 and 30-33 and a prima facie case of obviousness has, therefore, not been established has been considered but is not persuasive. Response: Applicants' are arguing the amendment to the claims. Therefore, this argument is considered moot.

Issue no. 2: Applicants' argue: McGregor fails to establish a prima facie case of obviousness with respect to claim 1, at least because the reference fails to teach each and every element of the claim has been considered but is not persuasive. Response: See MPEP 2144 entitled "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103: RATIONALE MAY BE IN A REFERENCE, OR REASONED

FROM COMMON KNOWLEDGE IN THE ART, SCIENTIFIC PRINCIPLES, ART – RECOGNIZED EQUIVALENTS, OR LEGAL PRECEDENT."

Further, the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied reference/references. In other words, the person having ordinary skill in the art has a level of knowledge apart from the content of the references. *In re Bode*, 550 F.2d 656, 660, 193 USPQ 12, 16 (CCPA 1977); *In re Jacoby*, 309 F.2d 513, 516, 135 USPQ 317, 319 (CCPA 1962). A conclusion of obviousness is established "from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference." *In re Bozek*, 416 F.2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969).

Please see the response to Issue no. 1 above. Since the argument is similar to Issue no. 1 the response is similar and there is no need to address the issue again.

The Examiner is entitled to give limitations their broadest reasonable interpretation in light of the Specification (see below):

2111 Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

During patent examination, the pending claims must be "given the broadest reasonable interpretation consistent with the specification." Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969).<

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Cook (US 6,999,944) disclosed a communications service, a bank card billing system or accumulating service charges during a billing period.

Wang et al (US 6,526,390) disclosed billing by wireless subscribers roaming to foreign wireless networks.

Hanson (US 6,885,857) disclosed telecommunications account processing and billing.

Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Inquiries

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.

The examiner can normally be reached on Monday, Tuesday, and Thursday, 5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 25, 2006

ELLA COLBERT
PRIMARY EXAMINER